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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,348	01/09/2004	John D. Summers	EL0538USNA	8319
23906 7590 05/17/2007 E I DU PONT DE NEMOURS AND COMPANY LEGAL PATENT RECORDS CENTER BARLEY MILL PLAZA 25/1128 4417 LANCASTER PIKE WILMINGTON, DE 19805			EXAMINER NILAND, PATRICK DENNIS	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 05/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/754,348	Applicant(s) SUMMERS ET AL.	
	Examiner Patrick D. Niland	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,8,10-22,24,25,27,29,31 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,8,10-22,24,25,27,29,31 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The amendment of 2/21/07 has been entered. Claims 1, 5, 8, 10-22, 24-25, 27, 29, 31, and 33 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 8, 10, 12-13, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. Application Publication No. 2004/0084774 Li et al..

This rejection is repeated as in paragraph 6 of the office action of 8/22/06.

The applicant's arguments that the argued compounds are structurally different compositions from the recited polynorbornene is not supported by probative evidence. It would appear that the polynorbornene of the reference should be that of the instant claims. The argument regarding peak curing profile and heat temperature of Li is not persuasive. The instant claims do not exclude heating to 350 C. As long as this heating gives the claimed water absorption, it reads on the instant claims. This rejection is therefore maintained.

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5. Claims 1, 5, 8, 10, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10-251343 (machine translation from JPO and abstract are used hereafter).

This rejection is repeated as in paragraph 7 of the office action of 8/22/06.

It is not seen that the instantly claimed norbornyl structure does not read on the polynorbornene of the reference since the claims do not exclude the reference's structure. The applicant's arguments that the reference does not disclose crosslinking and therefore there can be no motivation to use the instant formula II does not apply to claim 1 which requires no formula II. Crosslinking is clearly possible for the polynorbornene of the reference since it contains epoxy groups. This rejection is therefore maintained.

6. Claims 1, 5, 10, 14-15, 20-22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Pat. No. 6492443 Kodemura et al..

This rejection is repeated as in paragraph 8 of the office action of 8/22/06.

The polymer is a polynorbornene which appears to be that of the instant claims. It is therefore expected to have the same properties. The applicant has provided no evidence to the contrary. The massive amount of hydrocarbon will clearly repel water significantly. The sections recited in the prior office action regarding using the compositions of the patentee in capacitors and resistors contradicts the applicant's arguments regarding using the compositions as binder or encapsulant as "sealing parts", polymer compositions, "sealing materials for potting", and the remainder of the disclosure in this regard are clearly binder or encapsulant. Note column 23, lines 23-57. The dielectric constant and dielectric loss tangent of column 24, lines 1-20 also

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imply that the materials are useful as capacitor or resistor sealant or binder. The instant claims are directed to the composition per se, not the intended use. The applicant's arguments are therefore not persuasive.

7. Claims 16, 19 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6492443 Kodemura et al..

This rejection is repeated as in paragraph 10 of the office action of 8/22/06.

The polymer is a polynorbornene which appears to be that of the instant claims. It is therefore expected to have the same properties. The applicant has provided no evidence to the contrary. The massive amount of hydrocarbon will clearly repel water significantly. The sections recited in the prior office action regarding using the compositions of the patentee in capacitors and resistors contradicts the applicant's arguments regarding using the compositions as binder or encapsulant as "sealing parts", polymer compositions, "sealing materials for potting", and the remainder of the disclosure in this regard are clearly binder or encapsulant. Note column 23, lines 23-57. The dielectric constant and dielectric loss tangent of column 24, lines 1-20 also imply that the materials are useful as capacitor or resistor sealant or binder. No unexpected results are seen in using the binder of the patentee in the electronic articles discrete and planar capacitors. Its disclosed benefits to electronic devices would have been expected therein. The applicant's arguments are therefore not persuasive.

8. Claims 16-19, 25, 27, 29, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6492443 Kodemura et al. in view of US Pat. No. 5470643 Dorfman.

This rejection is maintained as stated in paragraph 11 of the office action of 8/22/06.

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The polymer is a polynorbornene which appears to be that of the instant claims. It is therefore expected to have the same properties. The applicant has provided no evidence to the contrary. The massive amount of hydrocarbon will clearly repel water significantly. The sections recited in the prior office action regarding using the compositions of the patentee in capacitors and resistors contradicts the applicant's arguments regarding using the compositions as binder or encapsulant as "sealing parts", polymer compositions, "sealing materials for potting", and the remainder of the disclosure in this regard are clearly binder or encapsulant. Note column 23, lines 23-57. The dielectric constant and dielectric loss tangent of column 24, lines 1-20 also imply that the materials are useful as capacitor or resistor sealant or binder. No unexpected results are seen in using the binder of the patentee in the electronic articles discrete and planar capacitors. Its disclosed benefits to electronic devices would have been expected therein. The applicant's arguments are therefore not persuasive. A resistor is an electronic device broadly encompassed by the language of the Kodemura reference for which Kodemura's binder is useful in making. No unexpected results stemming from the patentee's binder's use in resistors is seen in a manner commensurate in scope with the instant claims and the cited prior art.

9. Claims 16-18, 25, 27, 29, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 343 in view of US Pat. No. 5470643 Dorfman.

This rejection is maintained as stated in paragraph 13 of the office action of 8/22/06.

It is not seen that the instantly claimed norbornyl structure of JP 343 does not read on the polynorbornene of the reference since the claims do not exclude the reference's structure. The applicant's arguments that the reference does not disclose crosslinking and therefore there can be no motivation to use the instant formula II does not apply to claim 1 which requires no formula

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II. Crosslinking is clearly possible for the polynorbornene of the reference since it contains epoxy groups. The rejection provides the proper motivation to use the compositions in capacitors or resistors. This rejection is therefore maintained.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 343 as applied to claims 1-8, 10, 22, 23 above, in view of JP 04214778 (wherein the Derwent abstract is used hereafter).

This rejection is repeated as in paragraph 14 of the office action of 8/22/06.

This rejection is maintained and no arguments are seen for it.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patrick D. Niland
Primary Examiner
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